



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,687	01/24/2002	Shell S. Simpson	10008198-1	1020

7590 10/03/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DALENCOURT, YVES

ART UNIT PAPER NUMBER

2157

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,687

Applicant(s)

SIMPSON ET AL.

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

10

DETAILED ACTION

This office action is responsive to amendment filed on 07/21/2005.

Response to Amendment

The examiner has acknowledged the amended claims 2, 6, 19, 25, 26, and the Terminal Disclaimer.

Response to Arguments

Applicant's arguments filed on 07/21/2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments (pages 7 and 8), 37 CFR § 1.111(b) states, " A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. " Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references. In fact, Applicant has failed to acknowledge element 210, figure 3 in Grasso (US 2002/0116291), that the Examiner provided as being the " **enterprise resource planning system** "; and also failed to show how such element 210 is different from the claimed " **enterprise resource planning system** ".

In response to Applicant's argument (pages 9 and 10), the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary

and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971).

It has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

Applicant is reminded that “ **A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation “.** See In re Gulack, 217 USPQ 401 (CAFC 1983).

In accordance with In re Gulack, the source of the data does not affect the scope of the claim because it is not functionally interrelated with the “ configuring data at least partially obtained” acts.

In view of such, the rejection is sustained and repeated as follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2157

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 7 and 19 - 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Grasso et al (US 2002/0116291; hereinafter Grasso).

Regarding claim 1, Grasso teaches a method for accessing data (200, fig. 3), comprising the steps of configuring data at least partially obtained from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1 – 3; and [0062], lines 1 – 4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract content from captured documents and indexed); storing said data (paragraphs [0058], lines 3 – 8; [0062], lines 7 – 13; Grasso discloses that the service provider 210 records the document 120 in the digital archive it host for the user 50); and identifying said data to be accessed in response to a generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 2, Grasso teaches the method of claim 1, which further comprising the step of receiving said generic access instruction (paragraph [0064], lines 1 - 3); and accessing said data (paragraph [0064], lines 3 - 13).

Regarding claim 3, Grasso teaches the method of claim 1, wherein said storing said data comprises storing a portion of said data in an independent image format (paragraph [0020]).

Regarding claim 4, Grasso teaches the method of claim 1, which further comprises the step of generating a generic access request in response to said generic access instruction (paragraphs [0027] and [0032]; Grasso discloses that a recommendation may be generated based on a determination of document-document similarity (similarity of the requested document to other documents in the recommender system).

Regarding claim 5, Grasso teaches the method of claim 1, wherein said identifying comprises associating said data with a computer user (paragraphs [0028] and [0042]).

Regarding claim 6, Grasso teaches the method of claim 1, wherein said identifying comprises utilizing server side technology (paragraphs [0061] and [0064]).

Regarding claim 7, Grasso teaches the method of claim 1, wherein said identifying comprises utilizing client side technology (paragraphs [0061] and [0064]).

Regarding claim 19, Grasso teaches a system for accessing data comprising: apparatus for obtaining data from an enterprise resource planning ("ERP") system (210, fig. 3; paragraph [0057]; [0058], lines 1 – 3; and [0062], lines 1 – 4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); an apparatus for implementing a generic access instruction

Art Unit: 2157

(paragraph 0033); and an extension configured to respond to said generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 20, Grasso teaches the system of claim 19, wherein said generic access instruction causes said extension to access said data (paragraph [0058], lines 8 – 12; [0059]; and [0064]).

Regarding claim 21, Grasso teaches the system of claim 19, wherein said data represents an image having an independent format (paragraph [0020]).

Regarding claim 22, Grasso teaches the system of claim 19, wherein said generic access instruction causes a generic access request (paragraphs [0027] and [0032]; Grasso discloses that a recommendation may be generated based on a determination of document-document similarity (similarity of the requested document to other documents in the recommender system).

Regarding claim 23, Grasso teaches the system of claim 19, wherein said apparatus for implementing a generic access instruction includes communicating using the Internet (paragraphs [0028] and [0033]).

Regarding claim 24, Grasso teaches the system of claim 19, wherein said generic access instruction includes instruction communicated in hypertext transfer protocol (paragraph [0061], lines 9 - 14).

Regarding claim 25, Grasso teaches the system of claim 22, wherein said generic access request includes requests communicated by way of the Internet (paragraph [0063]).

Regarding claim 26, Grasso teaches a system for sharing data comprising: an apparatus for partially obtaining data from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1 – 3; and [0062], lines 1 – 4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); an extension configured to respond to a generic access instruction for communicating with web content containing a generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced); and an output device (paragraph [0028]).

Regarding claim 27, Grasso teaches the system of claim 26, wherein said generic access instruction causes said extension to access said data (paragraph [0058], lines 8 – 12; [0059]; and [0064]).

Regarding claim 28, Grasso teaches the system of claim 26, wherein said data from an enterprise resource planning system includes an image having an independent format (paragraph [0020]).

Regarding claim 29, Grasso teaches the system of claim 26, wherein said extension causes said data to be output using said output device (paragraph [0028]).

Regarding claim 30, Grasso teaches the system of claim 29, wherein said data output includes data output using the Internet (paragraph [0063]).

Regarding claim 31, Grasso teaches the system of claim 26, wherein said extension includes executing a browser (paragraph [0034]).

Regarding claim 32, Grasso teaches the system of claim 26, wherein said extension includes the characteristics of said client (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced).

Regarding claim 33, Grasso teaches the system of claim 26, wherein said data is associated with a user of said client (paragraphs [0028] and [0042]).

Regarding claim 34, Grasso teaches the system of claim 33, wherein said data is associated with said user using client side apparatus (paragraphs [0061] and [0064]).

Regarding claim 35, Grasso teaches the system of claim 33, wherein said data is associated with said user using server side apparatus (paragraphs [0061] and [0064]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al (US 2002/0116291; hereinafter Grasso) in view of John Croy (US 2001/0047384 A1; hereinafter Croy).

Regarding claim 8, Grasso teaches a method for outputting data () 10, fig. 1) comprising the steps of providing a client having capability to execute a web browser (paragraphs [0022]; [0031]; Grasso discloses that the recommender system may create a map of what has been printed in a work group. This information can then be browsed or searched from an electronic interface 60 to the system 100), providing an extension (paragraph [0031]); configuring data partially obtained from an enterprise resource planning system (210, fig. 3; paragraph [0057]; [0058], lines 1 – 3; and [0062], lines 1 – 4; Grasso discloses a distributed knowledge management service provider, wherein said service provider is an enterprise resource planning uses to extract textual content from captured documents and indexed); identifying said data to be accessed in response to a generic access instruction (paragraph [0058], lines 8 – 12; [0059]; and [0064]; Grasso discloses that the service provider 210 then transmits the print job to the user's printer 112 where the printed document is produced); communicating a first web

content to said client containing a generic access instruction causing a portion of said data to be accessed (paragraph [0064]; Grasso discloses that the service provider may provide an XML interface through which document content and user requests can be passed between the user interface and the server).

Grasso teaches substantially all the limitations, except for the use of communicating a second web content to said client providing capability for outputting said data; and outputting said data.

However, Croy teaches an analogous method and system for providing personalized content over a network, which comprises the steps of communicating a second web content to said client providing capability for outputting said data (103, fig. 1; paragraphs [0041], [0091], and [0092], lines 1 – 15. In particular Croy discloses the second server may provide computer code or machine commands to client (109) instructing the client to carry out certain actions or enabling the user (107) to perform certain actions on the client); and outputting said data (paragraphs [0041] and [0079]; Croy discloses that the second server may supply graphical or audio content which is presented to the user by the client).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Grasso's by communicating a second web content to said client providing capability for outputting said data; and outputting said data as evidenced by Croy. One of ordinary skill in the art would have found it motivated to utilize such a modification in order to provide Grasso's system the enhanced capability of allowing a server to provide a set of instructions which can be

used to generate audio on the user client, thereby saving processing resources, transmission time, and memory.

Regarding claim 9, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises associating said data with a computer user (paragraphs [0028] and [0042]).

Regarding claim 10, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises utilizing client side technology (paragraphs [0061] and [0064]).

Regarding claim 11, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said identifying comprises utilizing server side technology (paragraphs [0061] and [0064]).

Regarding claim 12, Grasso and Croy teach all the limitations in claim 8, and Grasso further comprises tailoring said extension to characteristics of said client (paragraph [0064]; Grasso discloses that the service provider may provide an XML interface through which document content and user requests can be passed between the user interface and the server. Using an XML interface offers several advantages in that a number of user interfaces are available which would be tailored in order to communicate with the service provider).

Regarding claim 13, Grasso and Croy teach all the limitations in claim 8, and Croy further teaches that said outputting said data includes outputting additional data (paragraph [0092], lines 15 – 18; Croy discloses that the data output can also be a

Art Unit: 2157

smaller file enabling faster download and less waiting because it may be only a component of the total audio).

One of ordinary skill in the art would have been motivated to utilize such a modification in order to further enhanced the system and method of Grasso by allowing a server to provide a set of instructions which can be used to output additional data on the user client, thereby saving processing resources, transmission time, and memory.

Regarding claim 14, Grasso and Croy teach all the limitations in claim 8, and Croy further teaches that said outputting said data includes outputting to multiple devices (paragraph [0091]).

One of ordinary skill in the art would have been motivated to utilize such a modification in order to further enhanced the system and method of Grasso by allowing a server to provide a set of instructions which can be used to output additional data to multiple devices, thereby saving processing resources, transmission time, and memory.

Regarding claim 15, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that said generic access instruction causes a portion of said data to be accessed causes additional data to be accessed (paragraph [0057]; Grasso discloses that in addition to capturing to providing recommender services to users of recording devices, other document related services may also be provided).

Regarding claim 16, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that a portion of said communicating said first web content utilizes a firewall (paragraphs [0061] and [0063]).

Regarding claim 17, Grasso and Croy teach all the limitations in claim 8, and Grasso further teaches that a portion of said communicating said first web content utilizes the Internet (paragraph [0063]).

Regarding claim 18, Grasso and Croy teach all the limitations in claim 8, and Grasso further comprising storing a portion of said data in an independent image format (paragraph [0020]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt
Y.D.
September 21, 2005


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100